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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/720,940	01/02/2001	Rainer Oschmann	113.1009	8398

7590

08/08/2003

WILLIAM GEHRIS  
DAVIDSON, DAVIDSON & KAPPEL,  
14th floor  
485 Seventh Avenue  
New York, NY 10018

EXAMINER

QAZI, SABIHA NAIM

ART UNIT

PAPER NUMBER

1616

DATE MAILED: 08/08/2003

10

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/720,940

Applicant(s)

OSCHMANN ET AL.

Examiner

Sabiha Qazi

Art Unit

1616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on 15 May 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☐ Claim(s) 11-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 11-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

Acknowledgement is made of the response filed in paper no. 9 dated 5/15/03. Claims 11-27 are pending. Amendments are entered. No claim is allowed.

This application is a 371 of PCT/DE99/0181206 filed on 6/19/1999. Preliminary amendments are entered. Arguments are not found persuasive therefore, rejection under 103 is maintained, others are withdrawn because claims are amended.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 11-18 and 25-27 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "including " or "include" may include elements other than those recited in claims. See *Exparte Russell*, 153 USPQ 752 (PTO Bd. App. 1966). It is unclear what is the meaning "include" in these claims.

Claims 11-18 rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claims 11-18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s)

Art Unit: 1616

contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Addition of “and not including a solubilization agent” is considered a new matter. Applicant is requested show the support of this amendment.

Claims 19-25 and new claims 25-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bombardelli et al. (US Patent 5,637,302). The reference teaches the extracts of *Ginkgo biloba* and their methods of preparation, which embraces applicant's claimed invention. See the entire document, especially 5-67 in col. 4 and examples of the reference. Instant claims differ from the reference in claiming water-soluble dry extract of *Ginkgo biloba*.

It would have been obvious to prepare dry extracts of *Ginkgo biloba* because prior art teaches the method for preparation of the extracts from aqueous mixtures of alcohols or ketone, which are miscible with water from the same plant. See lines 1-21 in col. 3 of the reference. See the examples of the reference where aqueous methanol is used for extraction and then concentrated to water (i.e. methanol is evaporated). At this point the extract is water-soluble which is then extracted with toluene-n-butanol mixture and dried.

Aqueous extraction of plant parts followed by drying the extract will contain water-soluble components of plant parts in the dry extract. This is considered obvious and nothing new is seen. The problem of solubility would be resolved if the extract contains a large amount of terpene lactones, favones and glycosides etc. In presently claimed invention a dry extract is prepared from the water-soluble portion of the extract. Drying a water-soluble extract is considered obvious to one skilled in the art at the time the invention was made.

One having ordinary skilled in the art by reading disclosure would be able to prepare the extract as instantly claimed, because *extract can be dried by several means which is convention and would have been obvious to one skilled in the art to freeze dry, or evaporate the solvent from the extract to get the dry extract. In absence of any criticality of the invention instant invention is considered obvious over the prior art of record.* Note, that the term “comprising” cited in claims is inclusive and fails to exclude unrecited steps. The use of the term comprising to introduce claimed structure means that the ingredients covered by these claims may involve more elements than those positively recited. *Ex parte Gottzein et al.*, 168 USPQ 176 (PTO Bd. App. 1969). Comprising leaves the claim open for inclusion of unspecified ingredients even in major amounts. *Ex parte Davis et al.*, 80 USPQ 448 (PTO Bd. App. 1948).

No criticality and/or unexpected results of invention is seen.

In the light of the forgoing discussion, the Examiner's ultimate legal conclusion is that the subject matter defined by the instant claims would have been obvious within the meaning of 35 U.S.C. 103(a).

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sabiha Qazi whose telephone number is 703-305-3910. The examiner can normally be reached on every business day..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman Page can be reached on 703-308-2927. The

Art Unit: 1616

fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4556 for regular communications and 703-308-4556 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.

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August 8, 2003



SABIHA QAZI, PH.D  
PRIMARY EXAMINER